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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/533,837

03/20/2006

Horst Lange

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EXAMINER

ZIMMER, MARC S

ART UNIT

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1796

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/533,837	<b>Applicant(s)</b> LANGE ET AL.	
	<b>Examiner</b> MARC S. ZIMMER	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09/02/06</u> .  | 6) <input type="checkbox"/> Other: _____                          |

In their pre-amendment, Applicant cancels claims 12-14 but claims having these numbers had never been earlier presented. Therefore, should Applicant add new claims in response to this Office action, the numbering should begin with claim 12, and not claim 15.

### ***Claim Objections***

Claims 1-11 are objected to because in one of the provisos appearing at the end of claim 1, the radicals Q are characterized as being "trivalent" in direct conflict with the formulaic representations of "Q" provided earlier in the claim, which are all divalent. Correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. They provide for the use of a copolymer, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 8 and 9 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under

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35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 and 7-14 of copending Application No. 10/533,769.

There is substantial overlap between the inventions where the moiety Q of the copending claims comprises an ammonium-containing residue. One distinction between them is that the co-pending claims do not stipulate that the radicals V<sup>1</sup> are devoid of ester groups. However, the co-pending claims, insofar as they are silent as to the presence/absence of ester groups, it is the Examiner's opinion that both those

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permutations wherein an ester group is present, and those where it is absent, are embraced. Of course, the claimed subject matter overlaps that of the co-pending application where the ester groups are absent from  $V^1$ . The other distinction between the claims is in the molar relationship between  $V^1$  and  $V^2$ . The present claims are actually broader than are the co-pending claims and, thus, contemplate both those embodiments where the mole contributions of  $V^1$  are much greater than that of  $V^2$ , much smaller, and everywhere in between.

A quick perusal of the dependent claims verifies that they mirror each other in the manner in which they limit the independent claim, claim 1.

This is a provisional obviousness-type double patenting rejection.

### ***Allowable Subject Matter***

Claims 1-11 are allowable over the prior art. The key limitations that seem to set apart the claimed invention from those of the prior art are the provisos (i) that  $V^1$  may not contain ester groups and (ii) that  $V^2/V^1 \neq 1$ . The significance of the latter limitation is that, in addition to the amine compound and polysiloxane macromer having between 20 and 1000 siloxane repeat units, there must structural contributions from a third reactant that, like the polysiloxane macromer, contains moieties that are chemically-complimentary with the amine reactant.

Lange et al., U.S. Patent # 7,041,767 and Lange et al., U.S. Patent # 7,217,777 are commonly assigned patents that, though they teach copolymers featuring many of the same claimed attributes, fail to even render obvious the claims because said

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copolymers fail to adhere to one or more of the aforementioned provisos. Zhang et al., U.S. Patent # 6,818,610 appears to teach copolymers that satisfy one, but not both, of said provisos. See, for instance, the copolymer outlined in Example 3.

DE 102004002208 appears to possibly teach a copolymer that satisfies all of the limitations attached to the claimed copolymers though the Examiner was unable to verify this absolutely because the document is published in German and the machine translation was unhelpful. See Example 3. In any case, this document fails to qualify as prior art because it published after the PCT filing date of this application, which has been filed under 35 U.S.C. 371.

Should Applicant manage to identify a strategy for overcoming the double-patenting rejections and those stated under 35 U.S.C. 101/112 outlined herein, the claims would be allowable.

As an aside, the ISA has cited several documents as being especially germane to the patentability of the claims but the present Examiner respectfully disagrees as to their applicability. It is not clear in a couple of these that the polymer even possesses ammonium groups and, moreover, the requirement that  $V^2/V^1 \neq 1$  does not appear to be satisfied by any of them.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARC S. ZIMMER whose telephone number is (571)272-1096. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

July 28, 2008

/Marc S. Zimmer/  
Primary Examiner, Art Unit 1796